

REMARKS

This responds to the Office Action mailed on January 3, 2008.

Claim 16 is amended, claims 1-15 are canceled, and no claims are added; as a result, claims 16-20 stand pending in this application. The amendments are fully supported by the current specification and do not add any new matter.

Interview Summary

Applicants thank Examiner Mark A. Fadok for the courtesy of a telephone interview on February 1, 2008 between the Examiner and the Applicants' representative, Ali Miresghhi. During the interview, the 112 and 102 rejections of claim 16 and the cited art were discussed and an agreement was reached that claim 16 would be amended to place the claim in a condition that would be closer to a condition for allowance.

§112 Rejection of the Claims

Claim 16 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claim 16 has been amended to address the rejection and further clarify the claimed subject matter. Thus, the amended claim 16 is fully supported by the current specification and complies with the enablement requirement. Accordingly, it is requested that the claim rejection under 35 U.S.C. § 112, first paragraph, be reconsidered, in light of the amendment, and withdrawn.

§102 Rejection of the Claims

Claims 16-19 were rejected under 35 U.S.C. § 102(e) for anticipation by Hu et al. (U.S. 7,197,465, hereinafter "Hu"). Applicants respectfully traverse the rejection for the reasons stated below.

Applicants respectfully submit that a *prima facie* case of anticipation cannot be made based on Hu, at least because Hu does not disclose each and every element of the Applicants' claimed subject matter.

To anticipate a claim, the reference must disclose every element of the claim. "A claim is

anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”¹

Amended claim 16 recites, in pertinent part:

an integrated shipping server hosted by a third party payment service, linked in communication with the web server, . . .

generating and serving web pages via which shipping information including sender address may be automatically entered into the web pages; and receiving shipping data pertaining to the shipment from the shipping vendor, said shipping data including data corresponding to a shipping label.

(Emphasis added throughout)

Hu provides “apparatus, systems and methods providing a printer interface in a global communications environment for a shipping management system resident on a server computer device remote from a user client computer device, that creates an image of a shipping label.”² In reviewing the portions of Hu relied upon by the Office Action, it can be seen that Hu does not teach the highlighted elements of the above claim 16 limitations. In discussing the limitation of “an integrated shipping server hosted by a third party payment service, linked in communication with the web server,” the Office Action has cited FIG. 1 of Hu. FIG. 1 is “an entity relationship diagram depicting the interface relationships provided by the System between Shippers as Sellers, Carriers, Recipients as Buyers, eCommerce /eAuction Providers.”³ However, FIG. 1 does not show *an integrated shipping server hosted by a third party payment service*, as recited by amended claim 16. As such, Hu does not disclose the claim 16 feature of “*an integrated shipping server hosted by a third party payment service, linked in communication with the web server*,” as recited by the amended claim 16.

Furthermore, the Office Action, in rejection of claim 16, while discussing the feature of “generating and serving web pages via which shipping information including . . . automatically entered . . .” has relied on Hu, at col. 27, lines 4-30 and FIGs. 12, 13, 57 and 58. Applicants respectfully submit that Hu, in the cited passage and FIGs., the *sender address* is not

¹ Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

² Hu, Abstract

³ Hu, col. 2, lines 52-56

automatically entered into any *web pages*. In the cited Figs. disclosed in Hu, the shown web pages require the *sender address* to be entered by the user/seller into web pages, whereas the package number is automatically entered. In particular, FIG 58 shows a label where everything is automatically provided. However, FIG 58 does not show a web page, as required by claim 16, and instead, FIG 58 merely displays a label. In the cited passage, Hu provides that package original address is retrieved from a system database:

“With the Seller's account number 210, the System accesses the System database . . . and retrieves the following types of information about the Seller: 1) Package origin address; 2) Carriers and services that the Seller has chosen to use; 3 . . . This type of information was collected by the System during the Seller's Registration process . . . FIG. 32 depicts an alternative embodiment of a hyperlink generated by the System. Instead of the hyperlink explicitly containing the Seller's account number 210 and package specific information, . . . the hyperlink depicted in FIG. 32 provides a Package Identifier ("PID") 220. A PID hides Seller account information and package specific information from the Buyer/Bidder”⁴

According to the above cited passage, Hu's system “accesses the system database” and retrieves “package origin address” and other information. The passages continues by stating that hyperlink depicted in FIG. 32 provides a Package Identifier. However, the passage is silent with respect to *automatically entering sender address into a webpage*, as required by the claim 16. As such, Hu fails to disclose the feature of “*generating and serving web pages via which shipping information including sender address may be automatically entered into the web pages*,” as recited in the amended claim 16.

The Office Action has also relied on Fig. 25 of Hu to reject the claim 16, which includes a limitation of “*receiving shipping data pertaining to the shipment from the shipping vendor, said shipping data including data corresponding to a shipping label*.” As described by the following passage, Fig. 25 does not teach this limitation. Hu, in Col. 19, lines 6-14 states:

FIG. 25 is a graphic representation of an exemplary embodiment of a Create a Seller's Link Screen 52. Before the System can create a Seller's link, the User must tell the System information about the particular package that will be shipped. Accordingly, as depicted in FIG. 25, the System asks the User to enter

⁴ Hu, col. 27, lines 4-30

the shipping weight and value of the item to be shipped 190. The User is asked to enter the Shipping Weight 191a.⁵

According to the above cited passage from Hu, Fig. 25 is a Create a Seller Link Screen, where the “User” must tell the system information about the package. For example the system asks the User to enter the shipping weight and value of the item to be shipped. However, the User in Hu is by no means a shipping vendor (e.g., United Parcel Service (UPS), Federal Express, etc., as stated in the current specification paragraph 5). Specifically, the User in Hu is a Shipper and is distinct from a carrier (see, for example, Hu, col. 10, lines 20-24). Furthermore, the passage is also silent with respect to *said shipping data including data corresponding to a shipping label*. Thus, Fig. 25 in Hu fails to teach the limitation of “*receiving shipping data pertaining to the shipment from the shipping vendor, said shipping data including data corresponding to a shipping label*,” as recited in claim 16.

Therefore, at least for the reasons set forth above, Hu fails to teach each and every element of claim 16. As such, Applicants respectfully submit that rejection under 102(e) of the independent claim 16 and its dependent claims 17-20 over Hu have been overcome. Thus, it is requested the claim rejections under 35 U.S.C. § 102(e) be reconsidered, in light of the amendments, and withdrawn.

§103 Rejection of the Claims

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hu et al. in view of Official Notice.

In consideration of the above 35 U.S.C. § 103(a) rejection, in light of the arguments presented above with respect to claim 16, Hu fails to anticipate the independent claim 16, and therefore also does not disclose the subject matter of dependent claims 17-20 which each add additional limitations to claim 16.

Applicants respectfully submit that the difference between claim 20 and the disclosure in Hu is significant and non-obvious to a person of ordinary skill in the art at the time of filing the application. Thus, claim 20 cannot be rendered obvious over Hu in view of Official Notice.

⁵ Hu, col. 19, lines 6-14

Applicants respectfully traverse, pursuant to MPEP 2144.03 and 37 CFR 1.113(b), the Examiner's taking of Official Notice that "the creation of a virtual [debit] card for use in payment for products or services was old and well known in the art at the time of the invention."

Applicants assert that the taking of official notice here is in error because the Examiner is alleging, without providing any supporting evidence, that the entire "creating" action of claim 20 is well known in the art, using Applicants claimed invention and hindsight as a roadmap to assert that the "creating" claim feature was "well known in the prior art at the time of the invention."

Applicants also note that with respect to one detail, the taking of official notice does not entirely focus on the claim language since the official notice refers to a "virtual credit card" rather than a "virtual debit card," as claim 20 requires.

Therefore, Applicants respectfully submit, for the reasons stated above, that because the Office Action has failed to meet the burden of making a prima facie showing of obviousness. Therefore, claim 20 is allowable. It is respectfully requested the claim rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' representative at 408-278-4053 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date March 3, 2008

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 3 day of March 2008.

Peter Polunski
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